## REMARKS

### I. Claim Rejections - 35 USC §112

The Examiner stated that claims 12-19 recite the limitation "as claim 11". The Examiner stated that there is insufficient antecedent basis for this limitation in the claims. The Examiner stated that the claims are missing claim 11. The Examiner considered claims 12-19 as dependent on independent Claim 10.

The Applicant notes that the claims were inadvertently mis-numbered without a claim 11. Therefore, claims 12-14 and 16-19 have been amended to be dependent upon claim 10. The Applicant notes that claim 15 is dependent upon claim 14. Based on the foregoing, the Applicant respectfully requests that 35 U.S.C. §112 rejections of claims 12-19 be withdrawn.

### II. Claim Rejections - 35 USC § 103

**Requirements for *Prima Facie* Obviousness**

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

> "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to

a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

*1. a reasonable expectation of success; and*

*2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).*

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

***Komar in view of Gayraud***

The Examiner rejected Claims 1-10 and 12-20 under 35 U.S.C. §103(a) as being unpatentable over Komar et al (US Patent Publication No. 2003/0079224 A1), hereinafter referred to as "Komar", in view of Gayraud et al. (U.S. Patent No. 5,436,637), hereinafter referred to as "Gayraud".

Regarding claim 1 and 10, the Examiner argued that Komar discloses a method and system comprising: a.) associating at least one object with a data item, wherein said at least one object contains information relevant to said data item (citing page 4, paragraph [0031] of Komar); and b.) displaying a compacted view of said data item in allocation of a display screen proximate to said at least

one object, and wherein a selection of said at least one object invokes a display of said information relevant to said data item (citing page 2, Paragraph [0016] of Komar).

However, the Examiner admitted that Komar does not explicitly disclose that said compacted view of said data item is a representation of said data item. The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59 of Gayraud). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Applicant respectfully disagrees with this assessment and notes that claims 1 and 10 have been amended in order to further clarify the Applicant's invention to include the following limitations: a) a searchable digital image database wherein said digital image database contains at least one data item; b) wherein said compacted view of said data item is displayed simultaneously with said display of said information relevant to said data item; and c) wherein said compacted view of said data item is a compacted representation of said data item.

The Applicant notes that the invention, as claimed, is a method and system for displaying information about a graphical image from a digital image collection. Information about the graphical images displayed can easily be displayed simultaneously with a thumbnail view of the image. A compacted view of a graphical image, also called a thumbnail in the art, is the same graphical image, only digitally compacted to a same thumbnail version of the graphical image. The

Applicant's paragraph [0042] discloses that a searchable database of digital images is maintained. The digital image is the "data item" of the independent claims. Paragraph [0046] and FIG. 4 discloses that the *compacted* view of the data item (thumbnail view of a graphical image) is displayed proximate with an "object" (i.e. iconette). The selection of the object displays information about the digital image itself (i.e. the data item), as shown in paragraph [0046] and FIG. 4. The information about the digital image and the thumbnail are displayed simultaneously, as disclosed also in FIG. 4. Therefore, in order to define the terms utilized in the Applicant's claims in more common language, a "data item" is a "graphical image", an "object" is an "iconette" and a "compacted view of a data item" is a "thumbnail".

Komar in view of Gayraud does not disclose these limitations of claims 1 and 10. Komar in view of Gayraud does not disclose maintaining a digital image database. Komar discloses a database as part of a computer system but does not disclose that the database is searchable or contains a digital image database. Additionally, the Examiner cites Komar for the disclosure of associating at least one object with a data item, wherein the object contains information relevant to the data item. Komar does not disclose this limitation.

Komar discloses a method and system wherein a video stream includes interactive areas wherein information on a *product* displayed can be retrieved. The Applicant claims a data item, a compacted view of the data item and information relevant to the *data item* itself, i.e. the digital image. Komar, on the other hand, displays information on the *product* pictured in the video stream. If Komar disclosed information on the data item, as claimed in the Applicant's claims 1 and 10, the information displayed in Komar would be relevant to the *digital image* displayed and not the product. The data item and the product pictured in the data item are not one and the same; the data item being the digital image itself (i.e. the data item) and the product being the item *represented* by the photograph.

Komar discloses this in paragraph [0041] of Komar as follows:

> "As discussed previously, actions associated with selectable display areas 141-142 (FIG. 1) can include the retrieval and/or display of various types of additional information related to the selected selectable display area. For example, a viewer could select a sports drink (one of selectable display areas 141-142) featured in a scene of video (video content 115, FIG. 1) displayed on display device 120. *One action associated with the sports drink could include the display of nutritional information about the sports drink. Another action associated with the sports drink could include the playing of an audio clip representing a radio commercial for the sports drink. Other data or information that can be displayed can include webpage or website content, images, a video clip, and the like. Other actions can include the display of a form, such as an order form or a survey.* In this case, action execution module 330 can retrieve the data necessary to generate the form and generate the form from this data. The viewer could then enter data into the fields of the form and the entered data could be sent to a recipient as submitted information 153. In this case, the action information field of the corresponding selectable display area of LUT 331 could include the recipient's location." (emphasis added)

As can been seen in the examples disclosed in Komar paragraph [0041] above, the display of information in Komar is relevant to the *sports drink* and is not relevant to the digital image of the sports drink (i.e. the data item). There is not an obviousness motivation in Komar to display information about the digital image, as Komar teaches that the motivation for the information pertains to the product. Information about the digital image and not about the product displayed in Komar would be useless to a user, as Komar discloses that the method is for a user to retrieve further information on products displayed in a video stream.

The Examiner has cited Komar paragraph [0016] for the disclosure of the limitation of displaying a compacted view of the data item in a location of a display screen proximate to the object, while admitting that Komar does not disclose that the compacted view is a representation of the data item. However, Komar does <u>not</u> disclose a compacted view of anything, only disclosing a selectable view in the video stream. The selectable view is not disclosed as a compacted view of anything at all. Komar also does not disclose an object proximate to the compacted view. Komar discloses a selectable view area without an object (i.e. iconette) which is proximate to the selectable view area. Komar does disclose that an icon which may *replace* the selectable display area but does not disclose that the icon (or object) is

proximate to a compacted view of a data item. Komar also does not specifically disclose that the displayed information about the product is displayed *simultaneously* with a compacted view of the data item, as in the Applicant's amended claims 1 and 10.

The Examiner admitted that Komar does not specifically disclose that the compacted view of the data item is a representation of the data item. The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents; however, the Examiner does not state that Gayraud discloses the limitation that is missing in Komar, i.e. that the compacted view of the data item is a representation of the data item. The Applicant refers the Examiner to the argument presented above about the data item and the compacted view of the data item. A compacted view of a data item is also referred to as a "thumbnail" view. Gayraud does not disclose a compacted view of a data item and does not disclose that a compacted view of a data item is a representation of the data item. The Examiner's citation in Gayraud does not mention anything about a compacted view or that a compacted view is a representation. The Gayraud citation is a disclosure of a GUI method and system and discloses the utilization of icons on a computer screen and does not mention or disclose thumbnail view or compacted view of a data item. Gayraud does not disclose the limitation which is missing from the Komar reference, as admitted by the Examiner. This is shown in the Examiner's citation form Gayraud (col. 3, lines 45-59), as follows:

> "According to the present invention, a graphical user interface includes improved interface components and methods for supplying the user with "hints" which enable users to completely discern the functionality of smart icons, interface objects, or other screen components of interest The "hints", which may be in the form of textual (or graphic) messages, are restricted to a non-intrusive location of the screen, typically located along one side (e.g., bottom or inferior portion) of a program's client area. When the screen cursor touches an object (e.g., enters a button) of interest, the system identifies the object with an appropriate descriptor hint displayed in the non-intrusive region."

Therefore, Komar in view of Gayraud fails to disclose the following limitations of the Applicant's claims 1 and 10: a) a searchable digital image database wherein said digital image database contains at least one data item; b) wherein said compacted view of said data item is displayed simultaneously with said display of said information relevant to said data item; c) wherein said compacted view of said data item is a compacted representation of said data item; and d) associating at least one object with a data item, wherein said at least one object contains information relevant to said data item. Komar in view of Gayraud, therefore, fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 1 and 10 are not disclosed.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 1 and 10 based on the Komar and Gayraud references be withdrawn.

Regarding claim 2 and 12, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses automatically invoking display of information relevant to said data item in response to dragging a graphically displayed cursor across said at least one object displayed on said display screen (citing page 2, paragraph [0021]; and page 4, paragraph [0031] and [0032] of Komar).

Regarding claim 3 and 13, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing page 2, paragraph [0016] of Komar).

Regarding claim 4 and 14, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item (citing page 3, paragraph [0025] and page 4, paragraph [0031] and [0032] of Komar).

Regarding claim 5 and 15, the Examiner argued that Komar and Gayraud disclose information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item as in claims 4 and 14 above and further discloses that the additional graphical window comprises an interactive region for initiating at least one user transaction thereof (citing page 2, paragraph [0016] of Komar).

Regarding claim 6 and 16, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses at least one object as a graphical iconette displayable on said display screen (citing page 2, paragraph [0016] and page 4, paragraph [0031] of Komar).

Regarding claim 7 and 17, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses that the item comprises a graphical image (citing page 2, paragraph [0017]) and page 3, paragraph [0026] of Komar).

Regarding claim 8 and 18, the Examiner argued that Komar and Gayraud disclose a method and system as in claims 1 and 10 above and further discloses displaying a compacted view of a plurality of data items in a display screen, wherein at least one data item among said plurality of data items is displayed proximate to at least one object containing information relevant to said at least one data item, wherein a selection of said at least one object invokes a display of information relevant to said at least one data item (citing page 2, paragraph [0016], page 23, paragraph [0023] and page 4, paragraph [0031] of Komar).

Regarding claim 9, Komar and Gayraud disclose a method as in claim 1 above and further discloses: a.) displaying data associated with said data item as a graphical icon on said display screen (citing page 2, paragraphs [0016] and [0020] of Komar); and b.) displaying said at least one object as a graphical iconette embedded within a graphical frame surrounding said graphical icon, wherein said

graphical iconette can be invoked by said user to display information relevant to said graphical icon (citing page 4, paragraph [0031] of Komar).

Regarding claim 20, the Examiner argued that Komar discloses a system comprising: a.) at least one iconette associated with a data item wherein said at least one iconette contains information relevant to said data item (citing page 4, paragraph [0031]); and b.) a display module for displaying a compacted view of said data item in a location of a display screen proximate to said at least one iconette, and wherein a selection of said at least one iconette invokes a display of information relevant to said data item wherein said display module displays data associated with said data item as a graphical icon on said display screen (citing page 2, paragraph [0016]; page 2, paragraph [0020]; and page 4, paragraph [0031]).

However, the Examiner admitted that Komar does not explicitly disclose that said compacted view of said data item is a representation of said data item. The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59 of Gayraud). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Applicant respectfully disagrees with these assessments and notes that the arguments presented above against the rejections of claims 1 and 10 apply equally against the rejections of claims 2-9 and 12-20. As presented above, Komar in view of Gayraud fails to disclose the following limitations of the Applicant's claims 1 and 10: a) a searchable digital image database wherein said digital image database contains at least one data item; b) wherein said compacted view of said

data item is displayed simultaneously with said display of said information relevant to said data item; c) wherein said compacted view of said data item is a compacted representation of said data item; and d) associating at least one object with a data item, wherein said at least one object contains information relevant to said data item. The Applicant notes that independent claim 20 has been amended to include the same additional limitations as in amended claims 1 and 10. The Applicant further notes that claim 7 has been amended to add missing punctuation.

The Applicant further notes that claim 13 has been amended to include the limitation wherein said display of information includes at least one of the following; copyrights, file size, file format, royalties file permissions and conditions of use. This is disclosed in the Applicant's paragraph [0006] as follows:

> [0006] Users need to know information about the image that pertains to its display and user (e.g., copyrights, permissions, file size, format, royalties, and other costs or conditions of use. In order to find and displays such information, users are often required to search through application or database and may be forced to leave the screen on which the relevant images are displayed. This is time consuming and can be confusing. In instances where multiple images are under consideration, it is even more difficult to track which image any specific block of metadata refers.

Additionally, the Applicant notes that as only 19 claims were originally submitted, claim 21 has been newly presented, making a total of 20 claims. Claim 21 includes the same limitations as amended claim 13, as shown above. Komar in view of Gayraud does not disclose these limitations wherein said display of information includes at least one of the following; copyrights, file size, file format, royalties file permissions and conditions of use.

Therefore, Komar in view of Gayraud fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 2-9 and 12-10 is not disclosed in the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 2-9 and 12-10 based on the Komar and Gayraud references be withdrawn. The Applicant

respectfully requests that newly presented claim 21 be allowed, based on the foregoing remarks.

## III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 and §112 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited. A Request for Continued Examination (RCE) under 37 CFR 1.114 is also submitted herewith, including the RCE fee of $810.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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